

REMARKS

Claims 1–10, 12, 15–21, 23 and 26–30 are pending. Claims 19–21, 23 and 26–30 are cancelled. Reconsideration of the application is requested.

§ 102 Rejections

Claims 29 and 30 are rejected under 35 USC § 102(b) as being anticipated by Lastovich, U.S. Patent Publication 2004/0007796.

Claims 29 and 30 are currently cancelled. Thus, this rejection is moot.

§ 103 Rejections

Claims 1, 3, 5–10, 12, 16–19, 21, 23, 26 and 27 are rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Publication 2004/0007796 (hereinafter Lastovich) in view of WO 2004/009172 (hereinafter Clarke). Claims 19–21, 23 and 26–30 are presently cancelled and thus the rejection of claims 19, 21, 23, 26 and 27 is moot.

The Patent Office asserts, *inter alia*, that Lastovich teaches at paragraph 48 "injecting the molten plastic material into the heated negative mold cavity [0048]" (from the Office Action, paragraph 9).

In fact, at paragraph 48, Lastovich teaches, in its entirety:

"The molded device can also be made using other molding processes. For example, a micro-device can be made by *embossing* a thermoplastic substrate with a mold or platen. The mold is provided with the impression of the desired molded micro-device. The device is formed by *pressing* the mold under pressure *against* the plastic substrate that has been heated to its softening temperature. Alternatively, the mold is heated and pressed against the thermoplastic substrate to mold the device." (emphasis added).

Thus, the Patent Office points to a paragraph of Lastovich that teaches embossing to support its rejection of the present claim 1 that is clearly directed to injection molding. It is immaterial whether Lastovich teaches heating a mold during embossing. The Patent Office has failed to point to where Lastovich teaches, suggests or describes doing so in combination with injection molding as claimed. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness.

The Patent Office points to nothing in Clarke to overcome the deficiency of Lastovich.

The rejection of claim 1 under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke has been overcome and should be withdrawn.

Claims 3, 5–10, 12, 16–18 each add additional features to claim 1. Claim 1 is patentable for the reasons given above. Thus, claims 3, 5–10, 12, 16–18 are likewise patentable.

In summary, the rejection of claims 1, 3, 5–10, 12, 16–18 under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke has been overcome and should be withdrawn.

Claims 2, 15 and 28 are rejected under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke in further view of U.S. Patent Publication 2002/0020688 (hereinafter Sherman). Claims 19–21, 23 and 26–30 are presently cancelled and thus the rejection of claim 28 is moot.

Similar to its rejection of claim 1, the Patent Office rejects claim 2, asserting that Lastovich teaches at paragraph 48 "injecting the molten plastic material into the heated negative mold cavity [0048]" (from the Office Action, paragraph 9). As above, Applicants respectfully submit that the Patent Office has not established that Lastovich teaches, suggests or describes this aspect of claim 2. The Patent Office points to a passage in Lastovich that relates to embossing, not to injection molding.

The Patent Office does not point to anything in Clarke or Sherman to overcome this deficiency.

Accordingly, Applicants kindly submit that the rejection of claim 2 under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke in further view of Sherman has been overcome and should be withdrawn.

Claim 15 adds additional features to claim 2. Claim 2 is patentable for the reasons given above. Thus, claim 15 is likewise patentable.

In summary, the rejection of claims 2 and 15 under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke has been overcome and should be withdrawn.

Claims 4 and 20 are rejected under 35 USC § 103(a) as being unpatentable over Lastovich in view of Clarke in further view of U.S. Patent 6,076,248 (hereinafter Hoopman). Claims 19–21, 23 and 26–30 are presently cancelled and thus the rejection of claim 20 is moot.

Claim 4 adds additional features to claim 3, which in turn depends from independent claim 1. Claim 1 is patentable for the reasons given above. The Patent Office does not point to anything in Hoopman that overcomes the deficiencies identified above with regard to the combination of Lastovich and Clarke. Thus, claim 4 is likewise patentable.

Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application as amended is requested.

Respectfully submitted,

May 12, 2009

Date

By: /Christopher M. Geise/

C. Michael Geise, Reg. No.: 58,560

Telephone No.: 651-736-3363

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833